

FILE COPY

U.S. - Supreme Court

FILED

MAY 3 1948

**Supreme Court of the United States**

**October Term, 1947**

**No. 784**

WHITIN MACHINE WORKS, a corporation,  
*Petitioner,*

*vs.*

WILLIAM G. REYNOLDS, EDGAR A. TERRELL,  
and THE TERRELL MACHINE COMPANY, a  
corporation,

*Respondents.*

**PETITION FOR WRIT OF CERTIORARI TO THE UNITED  
STATES CIRCUIT COURT OF APPEALS FOR THE  
FOURTH CIRCUIT, AND BRIEF IN SUPPORT THEREOF.**

✓  
NEWTON A. BURGESS,  
REGINALD HICKS,  
L. P. McLENDON,  
W. H. HOLDERNESS,  
*Counsel for Petitioner.*



# INDEX

	PAGE
PETITION FOR WRIT OF CERTIORARI .....	1
Summary and Short Statement of the Matter Involved .....	1
The General Subject Matter .....	2
The Two Reynolds Patents .....	4
The Questions Presented .....	5
Reasons Relied Upon for the Granting of the Writ .....	6
1. Virtual patent domination of an entire industry with no possible relief by way of conflict of decision .....	6
2. Conflict with decisions of this Court .....	6
3. An important question of patent law which has not been but which should be passed upon by this Court .....	7
4. Unlawful extension of the patent monopoly .....	7
5. Improper application of the law as to infringe- ment .....	8
BRIEF FOR PETITIONER IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI .....	9
The Opinions of the Courts Below .....	9
Jurisdiction .....	9
Statement .....	9
Specification of Errors .....	9
Summary of Argument .....	9
ARGUMENT .....	10
I. No Relief Possible by Way of Conflict of De- cisions Between Circuit Courts .....	10

	PAGE
II. Conflict With Decisions of this Court .....	13
(a) Failure to comply with R. S. 4888 .....	13
(b) Belated Insertion of Claims .....	17
III. Important Question of Patent Law .....	18
IV. Unlawful Extension of the Patent Monopoly .....	22
V. Improper Application of the Law as to Infringe- ment .....	23
Conclusion .....	24

### Authorities Cited

Bassick Manufacturing Co. v. R. M. Hollingshead Co., 298 U. S. 415 .....	23
General Electric Co. v. Wabash Appliance Co., 304 U. S. 364 .....	13, 18
Halliburton Oil Well Cementing Co. v. Walker, 329 U. S. 1 .....	13, 14, 15, 17, 18, 19, 20, 21, 23
Lincoln Engineering Co. v. Stewart Warner Corp., 303 U. S. 545 .....	23
Mackay Radio & Telegraph Co., Inc. v. Radio Corpora- tion of America, 306 U. S. 86 .....	10
Mercoid Corporation v. Mid-Continent Investment Co., et al., 320 U. S. 661 .....	24
Permutit Co. v. Graver Corporation, 284 U. S. 52 .....	18
Railway Co. v. Sayles, 97 U. S. 554 .....	17
Saco-Lowell et al. v. Reynolds et al., 141 F. (2d) 587 .....	10
Schriber-Schroth Co. v. The Cleveland Trust Company, 305 U. S. 47 .....	10
United Carbon Co. et al. v. Binney & Smith Co., 317 U. S. 228 .....	13, 16, 18
Webster v. Splitdorf Co., 264 U. S. 463 .....	17

### Statutes

R. S. 4888 (U. S. C. Title 35, Sec. 33) .....	13
Section 240(a) of the Judicial Code (28 U. S. C. 347) .....	9

# Supreme Court of the United States

October Term, 1947

WHITIN MACHINE WORKS, a corporation,  
*Petitioner,*

*vs.*

WILLIAM G. REYNOLDS, EDGAR A. TERRELL,  
and THE TERRELL MACHINE COMPANY,  
a corporation,

*Respondents.*

No.

## PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE FOURTH CIRCUIT.

*To the Honorable the Chief Justice and Associate Justices  
of the Supreme Court of the United States:*

Your petitioner prays that a writ of certiorari issue to review the decree of the United States Circuit Court of Appeals for the Fourth Circuit entered March 10, 1948, affirming a decree of the District Court of the United States for the Middle District of North Carolina. A certified transcript of the record in the case, including the proceedings in said Circuit Court of Appeals, is furnished herewith in compliance with Rule 38 of this Court.

### Summary and Short Statement of the Matter Involved.

In 1944 respondents charged petitioner with infringement of two Reynolds patents, No. 1,738,796 dated December 10, 1929 and No. 2,238,659 dated April 15, 1941.

In 1945 respondents brought suit against petitioner in the Superior Court of Cabarrus County, North Carolina,

seeking to recover on a common law theory of misappropriation of the patent subject matter. The cause was removed to the Federal District Court for the Middle District of North Carolina and, having no other way of securing an adjudication of the patents themselves, petitioner counter-claimed for a declaratory judgment of invalidity and non-infringement of the two Reynolds patents.

At the trial, the individual respondents both admitted that there was no infringement of the *first* Reynolds patent. The District Court adjudged the common law cause barred by the North Carolina Statute of Limitations but held the *second* Reynolds patent valid and infringed. The United States Circuit Court of Appeals for the Fourth Circuit affirmed, both as to the statutory bar and as to validity and infringement of the second Reynolds patent.

### **The General Subject Matter.**

In the manufacture of cotton yarn or thread, the raw stock is subjected to a series of preliminary operations, leading up to the conversion of the cotton into "sliver", which is a more or less ropelike length of loosely assembled fibers. In this sliver form, the cotton is ready for treatment in a roving frame.

From time immemorial, a roving frame has included at least two pairs of rolls, to which the sliver is fed. It goes through both roll pairs and, because the second pair rotates somewhat faster than the first, the sliver is subjected to a drawing or drafting operation, whereby it is attenuated. The sliver is also flattened, so that it emerges as a relatively wide, flimsy ribbon of fibers. Commonly, this attenuated sliver was then consolidated or compacted or restored to a more or less round form (of smaller girth than the original

sliver) to give it more strength and was then passed through a second and sometimes a third roving frame, the successive frames further drafting or attenuating the sliver just like the first. Finally, the sliver was fed to a spinning frame in which it was still further drafted and given a substantial twist to bring it to the form of thread or yarn.

It had been recognized long before Reynolds' first patent that certain manufacturing economies could be effected by combining in a single machine the successive drafts or drawings performed by the successive, individual, roving frames, with some mechanical means between drafts for "consolidating" or "reforming" the fragile ribbon to give it strength to withstand the succeeding draft or drafts. This combining of the operations in a single machine has long been known as multi-stage drafting in one process and the machines themselves as multi-stage or one process multi-stage drafting or roving machines. There are numerous examples of such machines in the prior art.\*

Both of the Reynolds patents relate to this old idea of using a single machine, rather than separate machines, to impart successive drafts to a sliver, with some form of consolidating or reforming mechanism between drafts.

For convenience, the conventional nomenclature for the various roll pairs may be noted at this point. The custom is to refer to the first pair of rolls which the sliver enters (at the back of the roving frame) as roll pair 1; the next pair as roll pair 2 and so on, toward the front of the machine. In a machine combining two drafts, there are four roll pairs. The first draft is between roll pairs 1 and 2. Between roll pairs 2 and 3 the strand is reformed or consolidated; and

---

\* Notwithstanding they clearly anticipate Reynolds, the prior art patents were condemned below as "abandoned experiments" and as "paper patents".

the second draft is between roll pairs 3 and 4. All of the foregoing long antedates Reynolds.\*

### **The Two Reynolds Patents.**

The mechanism of the *first* Reynolds patent comprised the known succession of roll pairs, alternating drafting stages and consolidating or reforming stages, but allegedly improved the older type of machine with respect to that part of it which effected the reforming of the strand between draft stages. Instead of using one of the prior art expedients (such as a funnel or tapering trumpet to bring the flattened ribbon of fibers into more compact form ready for the next draft), Reynolds' first patent incorporated a tongue and groove roll pair after each drafting stage. After the strand had passed through roll pairs 1 and 2 and had been drafted, Reynolds then passed the strand between the meshed tongue and groove of a special roll pair and thereby caused the edges of the strand to be folded over and in upon the body of the strand and condensed or consolidated ready for the next draft. The strand then passed through the next two pairs of rolls for a second draft, and so on.

The broad concept of successive draft stages with intervening consolidation being old, the patentability of the subject matter of Reynolds' first patent necessarily centered about the specific reforming means, namely, the tongue and groove roll idea. This patent, admittedly not infringed by petitioner, expired in 1946.

---

\* For reasons irrelevant to the granting of this petition, and hence not discussed herein, the old multi-stage roving frames of the prior art had not achieved any great commercial success, although the Casablancas machine was admittedly successful commercially prior to Reynolds.



The mechanism of the *second* Reynolds patent (applied for five years after the *issuance* of the first) not only discloses the same old succession of roll pairs but also the identical reforming means of the first patent, namely, the tongue and groove rolls between draft stages. The machine of the second patent differs structurally from that of the first only in one particular, which difference has been conveniently called "cascading". What this means is that the strand follows a broken path similar to a series of steps or falls instead of a straight path as in the first patent. Structurally, "cascading" is brought about simply by mounting certain of the roll pairs at successively lower levels than those which precede them. Whether cascading constitutes a patentable invention is of no consequence because petitioner does not use it or its equivalent.

This second Reynolds patent is full of ambiguous generalities and its claims are couched in wholly functional and indefinite terms. But, notwithstanding the antiquity of multi-stage drafting machines and the truly minor character of the "improvement" of the second Reynolds patent over the first patent and other prior art, this second patent, by the decisions below, has been accorded a position such that it now virtually precludes the use of one process multi-stage drafting in the cotton industry except upon payment of tribute to the respondents. Although the first Reynolds patent expired in 1946, the second does not expire until 1958.

### **The Questions Presented.**

The questions presented are whether the second Reynolds patent, No. 2,238,659, is valid and is infringed by the structure manufactured and sold by the petitioner.

### **Reasons Relied Upon for the Granting of the Writ.**

The discretionary powers of this Court are invoked upon the following grounds:

1. **Virtual patent domination of an entire industry with no possible relief by way of conflict of decision.** The second Reynolds patent, as sustained and construed below, now dominates essential machinery and the use thereof throughout the entire cotton industry. The only two large manufacturers of such machinery, both New England corporations and using two entirely different mechanisms, both have been the object of adverse decisions by the same District Judge in North Carolina and by the Court of Appeals of the Fourth Circuit, with respect to this same Reynolds patent. The only other manufacturer, a small factor at best, is likewise amenable to process in the Fourth Circuit and has been threatened with suit.\* Even if such third, small concern should be sued elsewhere, no conflict of decision could develop in time to relieve the situation with respect to the two major concerns, which, together, supply between 80 and 90 per cent of the cotton industry's needs. The validity and lawful scope of the second Reynolds patent are thus matters of wide public interest and importance.

2. **Conflict with decisions of this Court.** As respects the sustained "mechanism" claims, the decisions below are in conflict with and contrary to recent decisions of this Court: (a) in that such claims utterly fail to meet the requirements of R. S. 4888 and (b) in that they were inserted in Reynolds' application many years after the subject matter had gone into public use and over three years after the accused machines came on the market.

---

\* The respondent patent owners, all located in the Fourth Circuit, have not been amenable to process elsewhere for the purposes of a declaratory judgment action.

The decisions below sustaining the "process" claims in suit are likewise in conflict with and contrary to the principles of decisions of this Court; but the upholding of the "process" claims furnishes the basis of the additional specific ground set forth in the next point.

**3. An important question of patent law which has not been but which should be passed upon by this Court.** The Courts below have sustained certain mechanical "method" or "process" claims (which differ from "mechanism" claims only by the omission of the phrase "means for" at the beginning of each step of the "method") as if they were not subject to the same requirements as to definiteness under R. S. 4888 as "mechanism" or "apparatus" or "combination" claims; and, in so doing, have not only accorded the claims in question extraordinarily broad scope, but have virtually exempted such claims from the requirements of R. S. 4888 as applied by this Court to apparatus, product and combination claims. It is petitioner's view that there is no legal sanction for applying any lower standard of definiteness to a "mechanical method" claim than to an apparatus claim and thereby, in effect, circumventing the now settled law applicable to "means" claims. A definitive ruling on the question by this Court is believed to be of great importance to the public to put a halt to such domination and of importance also to the lower courts at large, to the Patent Office and to the entire patent bar.

**4. Unlawful extension of the patent monopoly.** The aforesaid dominating position over the cotton industry has been accorded a patent which differs in minor details only from a patent to the same inventor (the first Reynolds patent) which is "prior art" thereto and has now expired. The monopoly of the sustained claims is vastly broader than any claim allowed in the first patent and will extend

the broadened monopoly for some twelve years beyond the original seventeen year grant of that first patent.

**5. Improper application of the law as to infringement.** Petitioner is a manufacturer of machinery only. Concededly it has manufactured and sold the *machinery* held to infringe; but two of the sustained claims are directed to the art or method of manufacture as carried on only by the cotton mill purchasers of petitioner's machinery. For instance, one of the sustained claims is directed to a "*process of drawing fibrous material*" and another is for a "*method of cotton spinning*". Petitioner is not in the business of practicing and is not shown to have practiced the "process" or "method" of these claims. Such extension of "process" claims to dominate the manufacture and sale of *machinery* is believed to be in conflict with the spirit, if not the letter, of decisions of this Court.

In view of the dominating position which this second Reynolds patent now holds over the industry, the correct interpretation, and clarification if need be, of the applicable law of infringement is of considerable importance to the industry.

WHEREFORE, your petitioner respectfully prays that a writ of certiorari be issued to the United States Circuit Court of Appeals for the Fourth Circuit to the end that this cause may be reviewed and determined by this Court; that the decree of the Circuit Court of Appeals for the Fourth Circuit be vacated and set aside; and that petitioner be granted such other and further relief as may be proper.

WHITIN MACHINE WORKS, a corporation,

NEWTON A. BURGESS,

REGINALD HICKS,

L. P. McLENDON,

W. H. HOLDERNESS,

*Counsel for Petitioner.*

April 29, 1948.

## **BRIEF FOR PETITIONER IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.**

### **The Opinions of the Courts Below.**

At this writing the opinions of the Courts below are unreported but will appear in the Record, which is in process of printing at this writing and of which the page numbering is not yet available.

### **Jurisdiction.**

Jurisdiction is invoked under Section 240 (a) of the Judicial Code (28 U. S. C. 347).

### **Statement.**

The subject matter is outlined in the petition. In the interest of brevity, such additional facts as are necessary to be mentioned are incorporated in the ensuing argument in connection with the particular points to which they relate.

### **Specification of Errors.**

The errors which petitioner will urge if the writ is granted are that the Circuit Court of Appeals for the Fourth Circuit erred in holding claims 15, 22, 25, 27 and 28 of Reynolds' Patent No. 2,238,659 valid and infringed.

### **Summary of Argument.**

The points of the argument follow the reasons relied upon for the allowance of the writ and need not be repeated here.

## ARGUMENT.

### I.

#### **No Relief Possible by Way of Conflict of Decisions Between Circuit Courts.**

This ground has been recognized as warranting the exercise of the discretionary powers of this Court. *Schriber-Schroth Co. v. The Cleveland Trust Company*, 305 U. S. 47; *Mackay Radio & Telegraph Co., Inc. v. Radio Corporation of America*, 306 U. S. 86.

In the case at bar, between eighty and ninety percent of the needs of the cotton industry for machinery of the kind here involved are supplied by petitioner and by the only other large manufacturer in the field, Saco-Lowell Shops. While both of these companies are New England corporations, they both maintain branches or service establishments in North Carolina, incident to their supplying the needs of the cotton industry of the South.

Respondents first brought suit against Saco-Lowell Shops. The case was tried before Judge HAYES of the Middle District of North Carolina and his decision was affirmed by the Fourth Circuit Court of Appeals, 141 Fed. 2nd 587.

As appears from the opinion in that case, Saco-Lowell Shops had taken a license under Reynolds' *first* patent many years prior to the issuance of Reynolds' *second* patent, but the license was of such scope as to contemplate the inclusion of the second patent, when issued. Some years after they had taken that license, Saco-Lowell Shops com-

menced the manufacture of a quite different type of device and discontinued the payment of royalties. Charging that this device was subject to the payment of royalties under the broad agreement for a joint development of all of Reynolds' ideas, respondents brought suit on the contract against Saco-Lowell Shops.

As a licensee, Saco-Lowell Shops was estopped to deny validity and, of course, the action centered around the license agreement, but the Trial Court and the Court of Appeals went far outside of the issues and undertook to establish the validity of the second Reynolds' patent on a broad basis.

Having thus once succeeded in the Fourth Circuit, respondents initiated the present suit in North Carolina and it came to trial before the same District Judge, whose decision was again reviewed by the Fourth Circuit Court of Appeals. Not being a licensee, petitioner was at liberty to challenge the validity of Reynolds' second patent, but the opinion of the Court of Appeals was but an echo of the opinion it had rendered in the suit against Saco-Lowell Shops.

The all important issue here as to the invalidity of the claims in suit for failure to comply with the requirements of R. S. 4888 received scant attention. The opinion of the Court of Appeals reiterated much of its earlier opinion in the *Saco-Lowell* case, notwithstanding the fact that the issue of indefiniteness was not and could not have been tried out in that case.

Thus, these two concerns which supply virtually all of the machinery of the kind involved, have both come under the domination of the second Reynolds patent by virtue

of these two decisions of the same trial Judge and of the same Circuit Court of Appeals.

The remaining small percentage of the machinery affected which is not made or sold by petitioner or by Saco-Lowell Shops, is manufactured by Howard & Bullough Company. That concern makes and sells a still different form of device, but in the course of the trial of the case at bar, the respondent-inventor Reynolds charged that such still different device was also an infringement of his patent and said that suit would be brought when the instant case was disposed of.

Howard & Bullough Company is also amenable to process in the Fourth Circuit; but it is obvious that whether brought there or elsewhere and regardless of its outcome, a suit hereinafter brought against Howard & Bullough Company cannot lessen the effect of the decisions already rendered against Saco-Lowell Shops and petitioner, and hence cannot free the industry's major sources of supply and the public from the patent domination already established.

In these premises, it is believed that an unusually strong case exists for the exercise of the discretionary powers of this Court, to the end that it may review the question of validity and the scope of the second Reynolds patent.



## II.

**Conflict With Decisions of this Court.****(a) Failure to comply with R. S. 4888.**

This Court has had occasion to emphasize that a patent is necessarily invalid unless it comply with the requirements of R. S. 4888.\* *Halliburton Oil Well Cementing Co. v. Walker*, 329 U. S. 1; *United Carbon Co., et al. v. Binney & Smith Co.*, 317 U. S. 228; *General Electric Co. v. Wabash Appliance Co.*, 304 U. S. 364.

Not only must the patent specification be in "full, clear, concise and exact terms" and explain the subject "so as to distinguish it from other inventions", but also the inventor must "particularly point out and distinctly claim" what he claims as his invention or discovery.

The above-cited decisions make it abundantly clear that these essential statutory requirements are not satisfied when the language employed by the patentee, particularly in his claim, is "vague", "indefinite" or "functional", either in whole or "at the exact point of novelty".

---

\* The pertinent parts of the statute (U. S. C. Title 35, Sec. 33) read as follows:

"Before any inventor or discoverer shall receive a patent for his invention or discovery, he \* \* \* shall file in the Patent Office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions;" and "he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery."

In the *Halliburton* case (*supra*) this Court had occasion to expose the vice and the hazards to the public of such failures to comply with the statute in connection with the so-called "means" type of claim, in which the patentee claims his invention as consisting of "means for" followed by a statement of function; or, as this Court phrased it, "in terms of what it will do rather than in terms of its own physical characteristics".

The extent to which the decision below runs counter to the above pronouncements of this Court needs no demonstration beyond the quotation of a typical sustained claim, viz., claim 25, which, for more ready analysis, we separate into its component elements, as follows:

Claim 25.

1. Mechanism for drafting fibrous material in strand form having in combination [old]
2. means for drawing the strand, [old]
3. pairs of driven opposed rolls propelling the strand, [old]
4. (a) means acting on the strand intermediate its extent from the nip of one of such pairs to the nip of the next succeeding pair thereof [old]  
(b) to fold the strand longitudinally inward upon itself so that the fibers which lie at the lateral margins of the strand as the latter passes the first of such pairs of rolls are continuously shifted to occupy a position intermediate the width of the strand as the latter passes the succeeding pair of rolls,  
(c) the latter pair of rolls propelling the strand at a faster rate than the first of such pairs [old]  
(d) to take up the slack in certain portions of the cross-section of the strand incident to folding but without effecting any material draft of the entire width of the strand.

This, it will be noted, is a mechanism or apparatus claim and "elements" 1, 2, 3, 4(a) and 4(c) were all old even prior to Reynolds *first* patent. Element 4(b), in this very combination, was disclosed in Reynolds now expired *first* patent. If there is any novelty at all in this claim it hangs on "element" 4(d), which, indisputably, is not even for means but is a *wholly functional* characterization. There is not the slightest suggestion of novel structure but only a statement of allegedly novel function. Any mechanism, no matter how constructed and whether bearing close or no resemblance at all to the patent disclosure, would of necessity fall under the domination of such a claim provided only that it performed the stated functions or produced the same result.

This is precisely the type of claim condemned in the *Halliburton* case, in which the supposedly novel "means" was characterized merely as

"associated with said pressure responsive device for tuning said receiving means to the frequency of echoes from the tubing collars of said tubing section to clearly distinguish the echoes from said couplings from each other."

The two other sustained mechanism claims (27 and 28) are of the same type and exhibit the same characterization of the mechanism "in terms of what it will do rather than in terms of its own physical characteristics".

In spite of the foregoing, and without any discussion of the herein cited authorities, the decision below disposed of the subject of indefiniteness of the mechanism claims in two sentences, as follows:

"The contention is made that the claims are invalid because they do not distinctly claim the inven-

tion as required by R. S. 4888; but this contention is without merit, as an examination of the claims heretofore quoted amply demonstrates. We think that the claims are sufficiently specific; but, even if this were not true, the court would construe them in the light of the specification and drawings to save a meritorious patent." \*

Possibly, as in *United Carbon Co., et al. v. Binney & Smith Co. (supra)*, the Fourth Circuit Court of Appeals was again led astray by a misleading semblance of commercial success sought to be attributed to the second patent. That such success was not proven is amply demonstrable, although not proper to be argued here; but even if it existed, commercial success clearly could not serve as a substitute for compliance with the inflexible requirements of R. S. 4888. "To sustain claims so indefinite as not to give the notice required by the statute would be in direct contravention of the public interest which Congress therein recognized and sought to protect." *United Carbon Co., et al. v. Binney & Smith Co.*, page 233 (*supra*).

The conflict between the decision below and the controlling principles of the decisions of this Court in the cited cases is believed to be so flagrant as to warrant the issuance of the writ [Rule 38, para. 5(b)] and especially so in view of the established domination of the industry by this patent, which domination will continue for some twelve years more, to the great damage of the public, in the absence of a corrective decision by this Court.

---

\* Nowhere is there any attempt by the Court below to point to anything in the specification (or drawings) which could possibly shed such light as to avoid the plainly functional character of these mechanism claims.

**(b) Belated Insertion of Claims.**

While secondary to the point of indefiniteness of all three of the sustained mechanism claims, it is to be noted that two of these claims, viz., claims 27 and 28, were inserted in the patentee's application too late, under the settled law. They both relate to what has been termed a stationary form of the device, which is the type of the accused machine.

The application for the second Reynolds patent was filed July 23, 1934, but the applicant made no claim whatsoever to any stationary form of device until more than five years later, viz., in December, 1939, when these two claims 27 and 28 were put into the application. This belated expansion of the claims took place not only five years after the application had been filed, but three years after the industry had started to use the accused "stationary" device. They were admittedly added to cover the devices which had since come into use.

The sustaining of such claims, it is believed, is contrary to the principles of such decisions of this Court as *Railway Co. v. Sayles*, 97 U. S. 554, and *Webster v. Splitdorf Co.*, 264 U. S. 463.

Although the Court of Appeals rejected petitioner's contention in this regard, its decision suggests that it did entertain some doubt, saying: "even if claims 25 to 28 are disregarded, plaintiff is entitled to relief under claims 15 and 22" (the method claims).

It is petitioner's view that if the mechanism claims 25, 27 and 28 are bad, as petitioner contends, they should be so declared and they should not be imposed upon this vital industry as an appendage to or under the aegis of the "method" claims.\* The industry and the public at large are entitled to "know what part of the field is unoccupied". *Halliburton case (supra)*.

---

\* The method claims, 15 and 22, are discussed below under Point III.

## III.

## Important Question of Patent Law.

The question is whether mechanical method claims, which are even more "vague", "indefinite" and all-embracing in scope than the "means" type of claim condemned in the *Halliburton* and other cases, *supra*, are subject to the requirements of R. S. 4888. The importance of this question to the particular industry here affected and to the public at large is believed to merit the attention of this Court [Rule 38, para. 5(b)].

In the *United Carbon* case (*supra*), this Court stated (p. 237):

"Whether the vagueness of the claim has its source in the language employed or in the somewhat indeterminate character of the advance claimed to have been made in the art is not material. An invention **must** be capable of accurate definition, and it **must be** accurately defined, to be patentable. Cf. *General Electric Co. v. Wabash Corp.*, *supra*".

The rule thus stated has been applied to "composition" claims (as in the *United Carbon* case) to "product" claims (as in the *General Electric* case) and to "apparatus" claims (as in *Permutit Co. v. Graver Corporation*, 284 U. S. 52).

In the *Halliburton* case, the Ninth Circuit Court of Appeals sought to carve out an exception to the rule in favor of "combination" claims, but the notion that any such exception was permissible was flatly rejected by this Court.

In the case at bar the decision below would sanction another kind of exception, viz., in favor of a mechanical method claim.

It is petitioner's view that a claim of this character, such as claim 15 or claim 22 in suit (the only "method" claims involved) exhibits all of the vices of the functional "composition", "product", "apparatus" and "combination" claims heretofore condemned as failing to satisfy the statute and is an even greater barrier to progress and further development than the other types of claims and hence is just as contrary to the public interest as are those other types of claim. It is but the same contrivance in a slightly different guise.

Thus, where the apparatus type of claim, such as claim 25, is introduced by the phrase "Mechanism for (drafting fibrous material in strand form, etc.)" the mechanical method type of claim, such as claim 15, calls merely for "The process of (drawing fibres arranged in strand form, etc.)"; and throughout the so-called method claim the words "means for" are simply omitted.

In the left-hand column below, claim 15 is set out as it is worded in the patent; and in the right-hand column are

indicated the necessary substitute words to convert the "method" claim to a mechanism type of claim:

*Claim 15*

The process of	Mechanism for
drawing fibrous material arranged in strand form	(drawing fibrous material etc.)
which includes	means for
giving the strand a substantially uniform thickness throughout its width before drawing,	(giving the strand etc.)
then	means for
drawing the strand,	(drawing the strand)
and thereafter	and means for thereafter
restoring the strand to uniform thickness throughout its width,	(restoring the strand etc.)
and	and means for
holding the strand from vertical and transverse expansion throughout substantially the entire portion of its length following the said drawing and preceding the said restoration of uniform thickness.	(holding the strand etc.)

It has been shown that a claim comparable to the one set out in the right-hand column would (like claim 25, discussed under Point II) clearly be bad for the reasons emphasized in the *Halliburton* and other cases (*supra*). Obviously the claim becomes broader and even more vague and indefinite by dubbing it a "process" and omitting the words "means for" at the introduction of each phrase. In fact these so-called method or process claims are noth-



ing but statements of function of the machine and are not proper method claims at all.

If the use of such claims were sanctioned, it would obviously short circuit the intent of the Constitution and of the Congress, as evinced by the statute and by the decisions of this Court. The time has now come, it is submitted, when the lower courts should be apprised of the fact that there is no more justification for exempting such "method" claims from the operation of R. S. 4888 than there was for exempting the "means for" combination claims of the *Halliburton* case.

The Court below did not discuss the subject.\* The Court of Appeals contented itself by adding to the two sentences quoted above (p. 15) the statement that: "In addition to claims covering the machine of the invention, Reynolds was entitled to the broad process claims covering the process which he had discovered, without reference to specific instrumentalities". What the Court failed to recognize was that what it referred to as the "broad process claims" (claims 15 and 22) are no more than wholly functional mechanism claims in disguise.

As stated above, the question of the legality of claims of this character is important not only to the industry affected by the particular patent here involved, but also to all industry.

---

\* The Trial Court, which likewise made no mention whatsoever of the decisions relied upon by petitioner, prefaced its opinion with these remarks:

"This is a very complicated case and the most skillfully contested patent case which has confronted this court. Every inch has been hotly contested by brilliant counsel who have injected into this case virtually the entire works of patent law. It presents a striking example of a branch of federal court jurisdiction which should be set apart exclusively for determination by a court of competent patent experts instead of leaving it to judges who like myself are utterly devoid of mechanical skill and therefore unable to bring to the solution of the case the skill essential to the broader and better decision."

## IV.

**Unlawful Extension of the Patent Monopoly.**

Long prior to Reynolds, the art had recognized and many patents had disclosed that economies could be effected by uniting in one machine the successive pairs of rolls for making two or more drafts with reforming means between drafts.

Even at the time of Reynolds' first patent (1929), it was already too late to secure a broad patent on such an arrangement as consolidating the means for two or more drafts into one machine. Hence the first Reynolds patent, which fully disclosed such an arrangement, was properly confined in its claims to machines incorporating the particular kind of reforming or consolidating device which Reynolds proposed, viz., a tongue-and-groove roll pair.

The second Reynolds patent was not applied for until 1934, or five years after the **issuance** of the first Reynolds patent and did not issue until 1941. As pointed out in the petition, the first patent discloses the same combination of parts as those disclosed in the second patent. The "method" of the first patent is identical with that of the second. The machine of the second patent differs from the machine of the first patent in one minor structural feature only, viz., the cascading or stepped arrangement of the roll pairs (which is not used by petitioner or by Saco-Lowell Shops).

Nevertheless the claims allowed in Reynolds second patent and, in particular, the claims which have been sustained herein, are of vastly broader scope than anything contained and properly allowable even at the time of the issuance of Reynolds first patent. These broader claims of the second patent of necessity are functional. If they had

been limited to the structural difference from the prior art first patent there could be no infringement because the accused machines do not utilize that difference.

It is clear also that the claims of the second patent are for exhausted combinations and should be condemned for the reasons stated in *Lincoln Engineering Co. v. Stewart Warner Corp.*, 303 U. S. 545 and *Bassick Manufacturing Co. v. R. M. Hollingshead Co.*, 298 U. S. 415.

The character of the sustained claims has been discussed under Points II and III above and we merely point out here that the enlarged and extended monopoly is the direct result of the sustaining of claims of the wholly functional character indicated. It is a striking illustration of what this Court characterized in the *Halliburton* case as the hazards of carving out exceptions to the requirements of R. S. 4888.

It is believed that the situation presents such an unconscionable and protracted monopoly as to supply a further ground for review by this Court.

## V.

### **Improper Application of the Law as to Infringement.**

As already stated, two of the five claims in suit are in the form of process or method claims and have been sustained as such.

Petitioner is a manufacturer of textile machinery. The claimed process is one performed only by cotton mills.

No explanation has been advanced by respondents nor can any be found in the decisions below as to the theory upon which these claims can be said to have been infringed

by petitioner's manufacture and sale of machinery. If the theory is one of so-called contributory infringement, the Courts below have not so stated.

As the Court will recognize, the holding by the Court of Appeals that respondents are entitled to relief under the method claims "even if claims 25 to 28 are disregarded" makes it particularly important to determine not only the validity but also the practical limits of these *method* claims.

In view of the decision of this Court in *Mercoïd Corporation v. Mid-Continent Investment Co., et al.*, 320 U. S. 661, and to the end of determining whether the mere manufacture and sale of machinery is to continue for the next twelve years to be dominated by these *method* claims of the second Reynolds patent, it is urged that the Writ be issued and the case reviewed by this Court.

### ***Conclusion.***

***In the premises, it is earnestly urged that the petition be granted.***

Respectfully submitted,

NEWTON A. BURGESS,  
REGINALD HICKS,  
L. P. McLENDON,  
W. H. HOLDERNESS,  
*Counsel for Petitioner.*

April 29, 1948.

